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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 12/10/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/327,750

Applicant(s)

SATO, TAKA-AKI

Examiner

Jeanine A Goldberg

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-23,29,55,56 and 131-133 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4,8-23,29,55,56 and 131-133 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 8-23, 132, drawn to an isolated nucleic acid molecule encoding a polypeptide capable of binding with a p75<sup>ntr</sup> receptor, vectors, host cells, and method of producing the polypeptide, classified in class 536, subclass 23.1.
  - II. Claim 29, drawn to a polypeptide capable of binding with a p75<sup>ntr</sup> receptor, classified in class 530, subclass 350.
  - III. Claims 55-56, drawn to method for identifying compounds which are capable of inhibiting binding between p75<sup>ntr</sup> receptor and a capable of binding with a p75<sup>ntr</sup> receptor, classified in class 436, subclass 501.
  - IV. Claim 131, drawn to antibodies, classified in class 424, subclass 130.1.
  - V. Claim 133, drawn to a method of identifying an apoptosis-inducing compound, classified in class 436, subclass 501.

The inventions are distinct, each from the other because of the following reasons:

1. The inventions are distinct, each from the other because of the following reasons:
  - A) The inventions of Groups I, II, and IV are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of Group I is composed of nucleotides linked in phosphodiester bonds and arranged in space as a double helix. The polypeptide of Group II is composed of amino acids linked

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in peptide bonds and arranged spatially in a number of different tertiary structures including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The antibody of Group IV is also composed of amino acids linked in peptide bonds and arranged spatially in a very specific tertiary structure that allows that antibody to specifically bind to particular regions, i.e. epitopes, of the encoded polypeptide. Further, antibodies are glycosylated and their tertiary structure is unique, where four subunits (2 light chains and 2 heavy chains) associated via disulfide bonds into a Y-shaped symmetric dimer. Furthermore, the products of Groups I, II, IV can be used in materially different processes, for example, the DNA of Group I can be used in hybridization assays, the antibody of Group IV can be used in immunoassay, the polypeptide of Group II can be used to make fusion protein with an enzymatic function. Consequently, the reagents, reaction conditions, and reaction parameters required to make or use each invention are different. Therefore, the inventions of Groups I, II, IV are patentably distinct from each other.

B) Groups (I, II, IV) and (III, V) are patentable distinct inventions because the nucleic acids, proteins and antibodies of Groups I, II, IV is not relied upon in the method of Groups III or V. Instead Groups III and V uses compounds which is not specific to either of these compounds. Therefore, the inventions are novel and unobvious over one another. Alternatively in the event that nucleic acids, proteins and antibodies are the "compounds of the claims, the nucleic acids, proteins and antibodies could be used in materially different methods including hybridization assays, aptmer assays, purification methods and raising antibodies.

C) The methods of III and V are patentably distinct because they each have different objectives, different uses, different reagents and different method steps. The method of Group III is for identifying compounds capable of inhibiting. Alternatively, the method of Group V is for identifying apoptosis inducing compounds. Therefore the methods are distinct over one another.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.


3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday, Wednesday and Friday from 7:00 a.m. to 5:30 p.m. and Tuesday and Thursday from 7:00 a.m. 1:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Jeanine Enewold Goldberg  
December 3, 2001

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600